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MICROSOFT CORPORATION
ONE MICROSOFT WAY
REDMOND, WA 98052

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ISRAEL HILERIO, DAVID VAUGHN WINKLER, DANIEL R. THORNTON, MATTHEW R. COX, KAREN ELIZABETH PARKER ANDERSON, JESSE D. MCGATHA, and ADRIAN ROBERT BATEMAN

Appeal 2017-009405
Application 13/398,321[1]
Technology Center 2100

Before MAHSHID D. SAADAT, ALLEN R. MacDONALD, and JOHN P. PINKERTON, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–20, which constitute all the claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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[1] The real party in interest identified by Appellants is Microsoft Technology Licensing, LLC. App. Br. 3.

STATEMENT OF THE CASE

Introduction

Appellants' disclosed and claimed invention relates generally to installable applications that are to be used on a local client machine and that utilize an application cache manifest file that resides remotely to define various resources that are to be updated and available offline after the installed application has been deployed on the local client machine. Spec. ¶ 11.[2]

Claims 1 and 9 are representative and read as follows (with the disputed limitation *emphasized*):

> 1. A computer-implemented method comprising:
>
> initiating installation of an application on a local computing device, the application comprising an application that is not a web browser;
>
> downloading resources associated with an application manifest for the application;
>
> ascertaining existence of an updated remote application cache manifest for the application;
>
> identifying in the updated remote application cache manifest resources for the application that have been updated;
>
> *initiating a download independent of user interaction and downloading, from the remote application cache manifest for the application that is not a web browser, one or more of the resources that have been updated including limiting the types of resources to be downloaded from the remote application cache*

[2] Our Decision refers to the Final Office Action (mailed May 31, 2016, "Final Act."), Appellants' Appeal Brief (filed Oct. 31, 2016, "App. Br.") and Reply Brief (filed Jun. 21, 2017, ("Reply Br."), the Examiner's Answer (mailed Apr. 21, 2017, "Ans."), and the original Specification (filed Feb. 16, 2012, "Spec.").

manifest by excluding at least one of the resources based on the at least one resource including executable code; and

using the downloaded resources to execute the application on the local computing device.

9. One or more *computer-readable storage media* embodying computer readable instructions, which, when executed by a system, cause the system to perform operations comprising:

obtaining and reading an installable application package that includes an application manifest, the application manifest being utilized to download resources that are utilized by an associated application, the associated application not running in a web browser;

storing the downloaded resources in an application cache for use in online and offline scenarios;

utilizing the application cache to retrieve the resources that are to be utilized by the installed application;

checking for a remotely-located updated application manifest;

identifying in the remotely-located updated application manifest one or more updated resources for the application;

initiating a download independent of user interaction and downloading, from the remotely-located updated application manifest for the application not running in a web browser, the one or more updated resources including limiting the types of resources to be downloaded from the remotely-located updated application manifest by excluding at least one resource based on the at least one resource including executable code;

updating the application cache with the downloaded one or more updated resources; and

enabling use of the downloaded one or more updated resources for execution of the application.

App. Br. 29, 31–32 (App.).

Rejections on Appeal

Claims 9–15 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. (US 2012/0254352 A1; published Oct. 4, 2012) ("Ito"), in view of Bloch et al. (US 2007/0083486 A1; published Apr. 12, 2007) ("Bloch"), further in view of Lubbers et al., "Pro HTML5 Programming" (Apress, 2nd ed. 2011) ("Lubbers"), and further in view of Elgressy et al. (US 2001/0049795 A1; published Dec. 6, 2001) ("Elgressy").

ANALYSIS

Rejection of Claims 9–15 under § 101

Appellants argue the claimed "computer-readable storage medium" is directed to statutory subject matter under 35 U.S.C. § 101 because Appellants' specification expressly disclaims non-statutory subject matter from computer-readable storage media. *See* App. Br. 13–14.

This argument is persuasive. We agree with Appellants that Appellants' Specification defines "computer-readable storage media" as excluding a signal per se, as Appellants' Specification discloses that a computer-readable medium is configured as either a signal bearing medium (e.g., signal per se) or as a computer-readable storage medium, which is not a signal bearing medium. *See* Spec. ¶ 22. Accordingly, on this record, we do not sustain the Examiner's rejection of claims 9–15 as being directed to non-statutory subject matter under 35 U.S.C. § 101.

Rejection of Claims 1–20 under § 103(a)

Appellants argue the combination of cited references fails to teach or suggest, "initiating a download independent of user interaction and downloading, from the remote application cache manifest for the application that is not a web browser, one or more of the resources that have been updated including limiting the types of resources to be downloaded from the remote application cache manifest by excluding at least one of the resources based on the at least one resource including executable code," as recited in independent claim 1, and similarly recited in independent claims 9 and 16. *See* App. Br. 14. As argued by Appellants, the Examiner's reliance on four references for the aforementioned claim limitation presents an unworkable combination that would be logically difficult to create based on legally permissible motivations to combine. *See* App. Br. 15–16. Appellants further argue the Examiner's rationale for combining the references simply restates what the references are relied on to reject elements of the claims, and thus, the Examiner merely summarizes the claimed subject matter in an attempt to formulate a motivation to combine the references. *See* App. Br. 17–18.

We are not persuaded of reversible error. The Supreme Court has rejected the rigid requirement of demonstrating a teaching, suggestion, or motivation in the references to show obviousness. *See KSR Int'l Co., v. Teleflex Co.*, 550 U.S. 398, 415–16 (2007); *see also In re Ethicon, Inc.*, 844 F.3d 1344, 1350 (Fed. Cir. 2017) ("*KSR* directs that an explicit teaching, suggestion, or motivation in the references is not necessary to support a conclusion of obviousness."). Instead, "[t]he combination of familiar elements according to known methods is likely to be obvious when it does

no more than yield predictable results." *KSR*, 550 U.S. at 416. Further, the criterion for an obviousness rejection is not the number of references, but what they would have meant to a person of ordinary skill in the field of the invention. *See In re Gorman*, 933 F.2d 982, 986 (Fed. Cir. 1991). When the references are all in the same or analogous fields, knowledge thereof by the hypothetical person of ordinary skill is presumed, and the test is whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention. *See id.*

We agree with the Examiner's finding that Ito teaches a web browser that detects a manifest file, transmits a manifest acquisition request to a web server in accordance with the manifest file, and receives the manifest file in an application package of a web application, and that Ito teaches a push server that detects an update of the web application and performs a push transmission by transmitting an updated storage destination address related to a resource of the web application. *See* Final Act. 8–9 (citing Ito ¶¶ 41, 75). We further agree with the Examiner that Lubbers teaches a remote manifest file, and that replacing Ito's manifest file with Lubber's remote manifest file is merely a combination of familiar elements according to known methods that yields no more than predictable results, and thus, would have been obvious to one of ordinary skill in the art. *See* Final Act. 10–11 (citing Lubbers 301–302). Further, we agree with the Examiner Bloch teaches a software application that can access information offline and online (i.e., an application that is not a web browser), and that replacing Ito's web application with Bloch's software application is also a combination of familiar elements according to known methods that yields no more than predictable results, and thus, would have been obvious to one of ordinary

skill in the art. *See* Final Act. 11–12 (citing Bloch ¶¶ 32, 96). We also agree Elgressy teaches suppressing executable objects, and that the modification of Ito's system to suppress executable objects when downloading resources of the web application is also a combination of familiar elements according to known methods that yields no more than predictable results, and thus, would have been obvious to one of ordinary skill in the art. *See* Final Act. 12–13 (citing Elgressy ¶ 50).

Accordingly, we agree with the Examiner's finding that the combination of cited references teaches or suggests "initiating a download independent of user interaction and downloading, from the remote application cache manifest for the application that is not a web browser, one or more of the resources that have been updated including limiting the types of resources to be downloaded from the remote application cache manifest by excluding at least one of the resources based on the at least one resource including executable code," as recited in claim 1, and similarly recited in claims 9 and 16. *See* Final Act. 8–13; *see also* Ans. 4–11. Thus, we sustain the Examiner's rejection of claims 1, 9 and 16 for obviousness under 35 U.S.C. § 103(a). We also sustain the Examiner's rejection of claims 2–8, 10–15, and 17–20, which depend from one of claims 1, 9, and 16, and which are not argued separately.

DECISION

We reverse the Examiner's decision rejecting claims 9–15 under 35 U.S.C. § 101.

We affirm the Examiner's decision rejecting claims 1–20 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED